

REMARKS

By this Amendment, claims 1, 3, 13 and 14 are amended, claims 2, 15 and 16 are canceled, without prejudice or disclaimer of the matter therein, and claim 21 is added. Accordingly, claims 1, 3-14 and 17-21 are pending in this application. No new matter is added. Reconsideration of the application is respectfully requested.

The courtesies extended to Applicant's representative by Examiner Berezny at the interview held January 13, 2005 are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview. During the interview, Applicants' representative and the Examiner discussed the motivation for the combination of references asserted in the 35 U.S.C. §103 rejections.

I. Formal Matters

A. The Office Action rejects claims 9, 10 and 11 under 35 U.S.C. §112, second paragraph. Claim 1 is amended to provide proper antecedent basis for claims 9, 10 and 11. Accordingly, the withdrawal of this rejection is respectfully requested.

B. Claims 3 and 14 are amended to correct typographical errors.

II. The Pending Claims Define Patentable Subject Matter

A. The Office Action rejects claims 1, 4-5, 8-11, 13-14 and 17-18 under 35 U.S.C. §102(b) over U.S. Patent No. 5,242,841 to Smayling et al. (Smayling).

Claim 1 is amended to depend from claim 13, and claim 13 is amended to incorporate the features of canceled claim 15, which is not rejected over Smayling. Claims 4-5, 8-11, 13-14 and 17-18 variously depend from claim 13. As such, this rejection is rendered moot. Withdrawal of this rejection is respectfully requested.

B. The Office Action rejects claims 2, 12 and 15 under 35 U.S.C. §103(a) over Smayling in view of U.S. Patent No. 5,844,264 to Shinji. This rejection is respectfully traversed.

As described above, claim 15 is canceled and the features of canceled claim 15 are incorporated in claim 13.

The Office Action states that the motivation for combining Smayling and Shinji is to reduce defects and form an external connection because Shinji discloses a photodiode defined in the substrate and teaches reduction of micro white defects found in CCDs.

However, as discussed during the interview, Applicants respectfully submit that the motivation for combination is improper. That is, the Office Action admits that Smayling does not disclose a photodiode. Then, the Office Action states that Smayling would have looked to one such as Shinji for reducing defects and forming an external connection because Shinji discloses a photodiode. The Office Action asserts that one of ordinary skill in the art would have been motivated to combine Smayling with Shinji in order to reduce micro white defects.

However, this suggested motivation would only be proper if Smayling in fact taught a photodiode, such as that Shinji could provide a way to reduce a problem found in a device as taught by Smayling. In this particular case, Shinji's teaching of reducing micro white defects is not applicable to Smayling since Smayling does not disclose a photodiode. Thus, a device according to Smayling would not encounter micro white defects, and one of ordinary skill in the art would not have looked to Shinji.

Therefore, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine Smayling and Shinji. As such, Applicants respectfully submit that claim 13 is patentably distinct from the applied prior art.

The rejection of claim 2 is moot in view of its cancellation. Claim 12 is allowable at least for its dependency on a base claim, as well as for the features it recites.

Therefore, withdrawal of this rejection is respectfully requested.

C. The Office Action rejects claims 3, 6-7, 16 and 19-20 under 35 U.S.C. §103(a) over Smayling in view of U.S. Patent No. 6,580,138 to Kubena et al. (Kubena). This rejection is respectfully traversed.

Claims 3, 6-7 and 19-20 are allowable at least for their dependency from claim 13, as well as for the features they recite.

Claim 16 is canceled and written in independent form as new claim 21.

Smayling discloses a method for fabricating power and non-power devices on a semiconductor substrate by forming transistors (e.g., 139-149) on the substrate. The Office Action admits that Smayling does not disclose a microelectromechanical element and asserts that Kubena's teachings of a microelectromechanical (MEM) tunneling sensors and switches using dual wafers correspond to the recited microelectromechanical element.

However, Kubena's microelectromechanical tunneling sensors and switches are not circuit devices that would be manufactured by the method taught by Smayling. Although Smayling does disclose in column 1, lines 56-59, that "diverse devices" may be integrated on a single substrate, only "power" and "non-power" integrated circuits are disclosed in Smayling. Therefore, Smayling cannot reasonably be considered to suggest incorporating a microelectromechanical element, absent impermissible hindsight. Therefore, one of ordinary skill would not have been motivated to combine Smayling and Kubena, and the asserted combination is improper. As such, Applicants respectfully submit that claim 21 is patentably distinct from the applied prior art.

Accordingly, Applicants respectfully request withdrawal of this rejection.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-14 and 17-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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